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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,840	11/13/2003	Andrea Louise Guyon		4876
42812	7590	10/23/2006		
J. GORDON THOMSON P.O. BOX 8865 VICTORIA, BC V8V 3Z1 CANADA			EXAMINER VANAMAN, FRANK BENNETT	
			ART UNIT 3618	PAPER NUMBER

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/705,840	GUYON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Frank Vanaman	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 July 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

### **Status of Application**

1. Applicant's amendment, filed July 26, 2006, has been entered in the application. Claims 1-17 are pending, claim 18 having been canceled.

### **Claim Rejections - 35 USC § 112**

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 24, the recitation of a third width, which follows a recitation of a first width (line 20), wherein there is no intervening reference to a second width (the second width eventually being recited in line 30) is confusing.

### **Claim Rejections - 35 USC § 103**

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunke (US 4,811,504, cited previously). Bunke teaches a walking attachment (30) for a boot (15), which permits a wearer to walk on a walking surface, including a first contact plane adapted to contact a walking surface during a heel strike phase (rearwardly of the portion in contact with the surface at figure 2a, having a portion at approximately 45 degrees from horizontal); a second contact plane adapted to contact a surface during a transition between heel strike and flat foot phases (that portion in contact with the surface in figure 2a), a third contact plane adapted to contact a surface during a flat foot phase (that portion in contact with the surface in figure 2b); a fourth contact plane adapted to contact a surface during a transition between flat foot and toe-off phases (that portion in contact with the surface in figure 2c); and a fifth contact plane adapted to contact a surface during a toe off phase (that portion forwardly of the portion in contact with the surface in figure 2c; having a portion at approximately 45 degrees from the horizontal). The reference to Bunke, while teaching this structure for use with an attachment to a ski boot, fails to explicitly teach this sole structure as usable with an in-line skate guard. Inasmuch as the facilitation of a natural walking gait is deemed to be important by Bunke, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide the attachment in a shape adapted to be attached to an in-line skate, for the purpose of facilitating a more natural walking gait for an in-line skate user, allowing a more natural walking motion.

**Allowable Subject Matter**

5. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
6. Claims 2-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**Response to Comments**

7. Applicant's comments, filed with the amendment(s) have been carefully considered. The remaining pending rejection is based upon the reference to Bunke, which applicant has asserted cannot be applied in that it is non-analogous art. The examiner does not agree. Bunke is very specifically designed as an attachment for ski boots, and is adapted to provide a sole surface which facilitates walking. Bunke explicitly refers to the inflexible nature of a ski boot, and how such an arrangement interferes with walking (e.g., when a user has detached the boot from the ski). Applicant is reminded that the manner in which a user's foot is held in an in-line skate similarly restricts flexibility, and as such, the provision of an attachment which improves a user's ability to walk whilst wearing an article of footwear which is lacking in flexibility would be clearly beneficial to the users of any articles of footwear which are substantially rigid. As such, the facilitation of an improved gait for a user is achieved by both applicant and Bunke, and thus Bunke falls within a closely pertinent problem solving area. Applicant's comments concerning different classifications are noted, but are not persuasive inasmuch as different classifications do not necessarily support an assertion of non-analogous art. Applicant's comments concerning the width of the device taught by Bunke are noted, but appear to be directed to limitations which are not actually recited in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

*As regards reading unclaimed limitations from the specification into the claims*

From MPEP 2111:

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

**Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for

unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**



10/13/06